

Appl. No. 09/887,371  
Amdt. dated Dec. 22, 2003  
Reply to Office Action of June 20, 2003

### **REMARKS**

Claims 43-86 were pending and rejected in the above-identified application. Claims 43-86 were rejected on two grounds: 35 U.S.C. §102(b), and obvious-type double patenting. Pending claims 43-86 were amended. New claims 87-91 were added. Applicant respectfully requests that the above referenced rejections be reconsidered and withdrawn.

#### **I. OATH AND DECLARATION**

Apparently referring to the hand corrected address of some of the inventors, the office action asserts that "Non-initialed and/or non-dated alternations have been made to the oath or declaration. See 37 CFR § 1.52(c)." The office action thus required a new oath or declaration.

The office action is incorrect in this objection. 37 CFR § 1.52(c) does not pertain to alterations to the oath or declaration. On the contrary, it applies only to the "application papers", not the declaration. In pertinent part it states, "[A]lteration to of application papers filed must be made before the signing of any *accompanying* oath or declaration ...." Use of the word "accompanying" clearly means that the term "application papers" does not include the oath or declaration. 37 CFR § 1.52(c) is silent as to corrections to the oath or declaration.

Admittedly, MPEP § 602.01 provides that "The wording of an oath or declaration cannot be amended, altered, or changed in any manner after it has been signed ...." As noted above that procedure finds no support in the statute or regulations. But more importantly, MPEP § 602.01 further states, "[I]n some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper such as an application data sheet ... and a new oath or declaration is not necessary."

Accordingly, Applicant respectfully submits herewith a completed application data sheet that contains, among other data, the correct filing date and application number pursuant to 37 CFR 1.76.

#### **II. DOUBLE PATENTING REJECTION**

Claims 43-86 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-36 of commonly owned U.S. Patent No. U.S. Patent No. 6,464,851 B. The Examiner acknowledges that the claims are not identical.

Appl. No. 09/887,371  
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A terminal disclaimer is properly used to overcome a rejection based on a nonstatutory double patent ground when the conflicting patent is shown to be commonly owned with the present application. 37 CFR 1.130(b); MPEP §804.02(II). The present application and the cited patent, U.S. Patent No. 6,464,851, were commonly owned and subject to an obligation of assignment to Gradipore at the time the present invention was made. As such, Applicant respectfully submits the accompanying terminal disclaimer. The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. MPEP §804.02.

### III. REJECTION UNDER 35 U.S.C. §102(b)

Claims 43-86 are rejected under 35 U.S.C. §102(b) as being anticipated by Mullan. Mullan was also cited as an anticipating reference in the parent application (Ser. No. 09/470,823), which ultimately issued as U.S. Patent No. 6,464,851. Applicant respectfully traverses on the same ground set forth in Applicant's response to office action, filed on March 21, 2001 in the parent application, as well as the oral arguments heard by the examiner during the telephonic interview of May 23, 2001 (and summarized in Applicant's supplemental response to office action filed on May 30, 2001). That is, Claims 43-57, 60-61, 79, 82, 85-86 have been amended to incorporate the claim limitation, *i.e.*, "substantially all transmembrane migration of the selected compound is initiated by application of the electric potential", which the Examiner has already determined with respect to the parent case Mullan does not teach. Likewise, new claims 87-91 also incorporate that claim limitation. The limitation "concurrently" has been deleted from the claims as an unnecessary limitation. The remaining amendments to the claims provide correct antecedent basis and proper English, which changes were not made for purposes of patentability. Accordingly, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

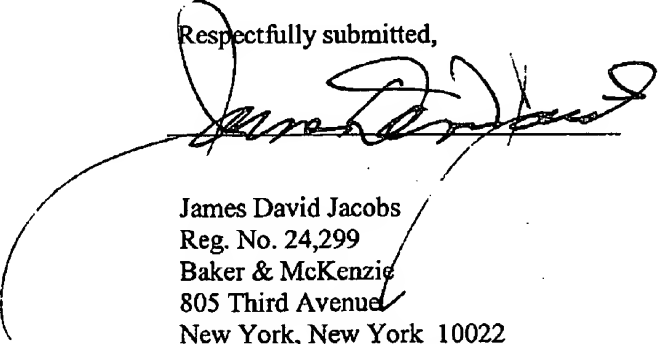
Appl. No. 09/887,371  
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### CONCLUSION

In view of the foregoing amendments and arguments, Applicant respectfully submits that the claims are in condition for allowance. If the Examiner has any questions regarding this Response to Office action or the Application in general, the Examiner is invited to contact the Applicant's attorney at the below listed telephone number. If the Commissioner determines that additional fees are due, please charge our Deposit Account No. 02-0393.

Date: December 22, 2003

Respectfully submitted,



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